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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/630,428	07/30/2003	Todd Aldridge Russell	CL/V-30654C/C.GV2040/DIV2	7831

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NOVARTIS  
CORPORATE INTELLECTUAL PROPERTY  
ONE HEALTH PLAZA 104/3  
EAST HANOVER, NJ 07936-1080

EXAMINER

HECKENBERG JR, DONALD H

ART UNIT	PAPER NUMBER
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1722

DATE MAILED: 02/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/630,428

Applicant(s)

RUSSELL, TODD ALDRIDGE

Examiner

Donald Heckenberg

Art Unit

1722

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 16-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 16-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on July 30, 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

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1. The first line of the specification needs to be updated to reflect that the parent application, U.S. Ser. No. 10/283,718, has issued as U.S. Pat. No. 6,783,603.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 16 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Japanese Pub. No. 61-072633 (hereinafter "JP '633"). Reference below will be made to the drawings of this reference as well as the English abstract (which is fully supported by the document) also made of record with this Office Action.

JP '633 discloses an apparatus for cleaning the mold surface of a lens molding device. The apparatus comprises a chamber (15) which forms a confined area around the mold (11 and 12). An outlet (15b) for an outflow of gas is provided. Also provided is an inlet (15d and 15e) for injecting an inflow of compressed gas. The inlet and outlet are connected to the

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chamber as such that the inflow and outflow of gas clean the mold (see Abstract).

Claim 19 recites that the particular compressed gas used in the claimed apparatus is filtered air. This limitation is directed to the intended use of the apparatus. It is well settled that the intended use of an apparatus is not germane to the issue of patentability of the apparatus. If the prior art structure is capable of performing the claimed use, then it meets the claim limitation(s). In re Casey, 370 F.2d 576, 580 152 USPQ 235, 238 (CCPA 1967); In re Otto, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963); MPEP § 2115. In the instant case, the apparatus disclosed by JP '633 is as such that filter air could be used for the compressed gas, and thus the reference anticipates claim 19.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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5. The factual inquiries set forth in Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claim 16-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Keene et al. (U.S. Pat. No. 5,363,647).

Keene discloses a device for removing a lens from a container surface (12). The device comprises a chamber which forms a confined area (Fig. 1). An inlet (24) and an outlet (26) are provided for the injecting and release of a compressed gas from the chamber (see Fig. 1). As such, liquid is removed from the surface of the container and therefore "cleaned" (cl. 4, ll. 66-68). Keene also discloses the device to comprise a carrier (14) for holding the container, and that the container and carrier have conforming ridges and flanges (see Fig. 1). Keene still further discloses providing a vacuum source to create the outflow (cl. 5, ll. 23-28).

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Keene does not disclose the structures (12) used in the apparatus to be a mold, instead noting that they are "containers." However, Keene notes that the apparatus is used as part of the lens molding process, (cl. 1, l. 9 - cl. 2, l. 4). Thus, it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to have modified the device of Keene as such to have containers disclosed by Keene be the molds because the apparatus is specifically designed for use with the molding process as noted by Keene.

Keene also does not explicitly disclose the carrier to hold a multitude of container (molding) structures. However, notes that it is desirable to process more than one container at a time, and describes modifications to parts of the apparatus for such a use (cl. 4, ll. 18-24). Thus, it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to have modified the device disclosed by Keene as such to have made the carrier mold hold a multitude of containers at one time because, as noted by Keene, it is desirable to process more than one container at a time.

7. The following reference cited but not relied upon is deemed pertinent to the instant application:

Hoffman et al. (U.S. Pat. No. 5,607,518) discloses methods of deblocking and extracting and cleaning polymeric articles with supercritical fluids.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald Heckenberg whose telephone number is (571) 272-1131. The examiner can normally be reached on Monday through Friday from 9:30 A.M. to 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Benjamin Utech, can be reached at (571) 272-1137. The official fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <<<http://pair-direct.uspto.gov>>>. Should you have questions

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on access to the Private PAIR system, contact the Electronic  
Business Center (EBC) at (866) 217-9197 (toll-free).

 2-22-5  
Donald Heckenberg  
A.U. 1722